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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,541	12/19/2001	Richard Joseph Caballero	M-12420-2C US	2447

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EXAMINER

O'CONNOR, GERALD J

ART UNIT PAPER NUMBER

3627

DATE MAILED: 10/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/028,541

Applicant(s)

Caballero et al.

Examiner

O'Connor

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on July 8, 2005 (Election w/Amendment).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 45-75 is/are pending in the application.
- 4a) Of the above claim(s) 45-75 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on June 18, 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Preliminary Remarks

1. This Office action responds to the amendment and election filed by applicant on July 8, 2005 in reply to the previous Office action, mailed June 3, 2005.
2. The amendment of claims 1, 10-12, and 14; cancellation of claims 16-44; and, addition of claims 45-75, in the reply filed by applicant on July 8, 2005, are all hereby acknowledged.

Election/Restriction

3. Applicant's election without traverse of the invention of Group I, claims 1-15, in the reply filed July 8, 2005 is hereby acknowledged.
4. Newly submitted claims 45-59 (Invention IV) are directed to an invention that is independent or distinct from the invention originally claimed (Invention I) for the following reasons:

Inventions I and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In this case, Invention I has separate utility from Invention IV, such as for use

manually by a call center operator receiving information from a customer via telephone; and, Invention IV has separate utility from Invention I, such as for automated information taking over the Internet without any manual operator or user other than the customer. See MPEP § 806.05(d).

5. Newly submitted claims 60-75 (Invention V) are directed to an invention that is independent or distinct from the invention originally claimed (Invention I) for the following reasons:

Inventions I and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In this case, Invention I has separate utility from Invention V, such as for use with orders paid for with a credit card account; and, Invention V has separate utility from Invention I, such as for use with orders paid for with cash. See MPEP § 806.05(d).

6. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 45-75 are withdrawn from consideration as being directed to non-elected inventions. See 37 CFR 1.142(b) and MPEP § 821.03.

Priority

7. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The second application must be an application for a patent for an invention which is also disclosed in the first application (the parent or provisional application); the disclosure of the invention in the parent application and in the second application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

Additionally, note that applicants' declaration specifically addresses the issues of both foreign and domestic priority, and specifically indicates that no priority documents exist.

8. This application repeats a substantial portion of prior Application No. 10/024,691 (Attorney Docket No. "SBL0020US"), filed December 17, 2001 (i.e., merely two days prior to the filing date of the instant application), and adds and claims additional disclosure not presented in the prior application. Since this application names an inventor or inventors named in the prior application, it may constitute a continuation-in-part of the prior application. Should applicant desire to obtain the benefit of the two-day-earlier filing date of the prior application, attention is directed to 35 U.S.C. 120 and 37 CFR 1.78.

Specification

9. The disclosure is objected to because of the following informalities: the cross references to related applications section (page 1) needs to be updated to reflect the correct/proper/current identification and status of any such applications (Note that the office has no record of any case having an attorney docket number of "M-12420 US").

Appropriate correction is required.

Claim Objections

10. Claims 14 and 15 are objected to because of the following informalities: it appears that "quote; and" (claim 14, line 4) was intended to be --quote;--, and, it appears that "address." (claim 14, line 6) was intended to be --address; and--, which changes will both be assumed for purposes of further consideration of the claims hereinbelow. Appropriate correction is required.

Claim Rejections - 35 USC § 101

11. The following is a quotation of 35 U.S.C. 101:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

12. Claims 1-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-15 are drawn to a method of producing a disembodied data structure. It has been held that such claims are considered to comprise non-statutory subject

matter, for merely manipulating an abstract idea without producing any “useful, concrete, and tangible result.” *In re Warmerdam*, 33 F.3d 1354; 31 USPQ2d 1754 (Fed. Cir. 1994).

Additionally, method claims that fail to *require* the use of any technology, such as claims 1-15, are considered non-statutory under § 101, for failing to fall within the technological arts. Claims must be tied to a technological art. To overcome this aspect of the rejection, a positive limitation in the body of the claim is required to recite the use of some technology, such as either a computer, *per se*, or else some other computer element that would inherently and necessarily require a computer (e.g., a website), or else some other aspect or element of technology.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

14. Claims 1-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Wiecha et al. (US 5,870,717).

Wiecha et al. disclose a method, the method comprising: generating a list of accounts; detecting selection of one of the accounts; generating a list of orders associated with the selected account, wherein the list of orders comprises orders that have been submitted for provisioning; detecting selection of one of the orders that has been submitted for provisioning; detecting a request to change the selected order; incorporating the change in the selected order; re-submitting the order for provisioning; and, synchronizing the re-submitted order in an external provisioning system to override the order that had been previously submitted for provisioning.

Regarding claim 2, the method of Wiecha et al. further comprises: generating a list of items comprising the selected order; determining whether each item in the list of items has been delivered; detecting selection of one of the items; and, allowing a user to reconfigure the selected item if the selected item has not been delivered.

Regarding claim 3, the method of Wiecha et al. further comprises: changing the status of the selected item to indicate that the selected item has been updated.

Regarding claim 4, the method of Wiecha et al. further comprises: changing the status of the selected order to indicate that the order has been updated.

Regarding claim 5, the method of Wiecha et al. further comprises: generating a list of quotes associated with the selected account.

Regarding claim 6, the method of Wiecha et al. further comprises: generating a list of quotes associated with the selected account; detecting selection of one of the quotes; detecting a request to change the selected quote; and, incorporating the change in the quote.

Regarding claim 7, the method of Wiecha et al. further comprises: generating a list of assets associated with the selected account; detecting selection of one of the assets; detecting a request to change the selected asset; and, incorporating the change to the asset in a quote.

Regarding claim 8, the method of Wiecha et al. further comprises: submitting the quote to an order.

Regarding claim 9, the method of Wiecha et al. further comprises: generating a list of items comprising the selected asset; detecting selection of one of the items; and, allowing a user to reconfigure the selected item.

1 Regarding claim 10, the method of Wiecha et al. further comprises: ungrouping the selected item with a quantity of more than one to a corresponding multiple of items; and, allowing the user to reconfigure each item of the multiple of items individually.

Regarding claim 11, the method of Wiecha et al. further comprises: , further comprising: generating a list of quotes associated with the selected account; detecting selection of one of the quotes; and, detecting selection of an option to update potential revenue based on the price of items in the selected quote.

Regarding claim 12, the method of Wiecha et al. further comprises: detecting selection of an option to create a quote for a new asset, wherein the quote is associated with the selected

account; generating a list assets comprising products and services available; detecting selection of an asset; and, invoking a product configurator to allow the user to configure the selected asset.

Regarding claim 13, in the method of Wiecha et al. the change comprises disconnecting the asset.

Regarding claim 14, in the method of Wiecha et al. the change comprises transferring the asset, the method further comprising: detecting selection of an option to transfer the asset; copying information about the configuration of the asset to a quote; setting the status of items in the quote to indicate that the items are to be included in a service profile at a new address; and, copying information about the asset.

Regarding claim 15, the method of Wiecha et al. further comprises: copying the information about the configuration of the asset to a second quote; and, setting the status of items in the quote to indicate that the items are to be disconnected in a service profile at an old address.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to the disclosure.

16. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(571) 272-6787**, and whose facsimile number is **(571) 273-6787**.

The examiner can normally be reached weekdays from 9:30 to 6:00.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor,
Mr. Alexander Kalinowski, can be reached at (571) 272-6771.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand
delivery. **Faxed replies are preferred and should be directed to (571) 273-8300.** Mailed replies
should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450."
Hand delivered replies should be delivered to the "Customer Service Window, Randolph Building,
401 Dulany Street, Alexandria, VA 22314."

GJOC

September 30, 2005

 9/30/05

Gerald J. O'Connor
Primary Examiner
Group Art Unit 3627